

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM S. YAMANASHI and ARUN A. PATIL

Appeal No. 97-0879
Application 08/101,228¹

ON BRIEF

Before COHEN, McQUADE and BARRETT, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 13, all of the claims pending in the application.

¹ Application for patent filed August 3, 1993. According to appellants, the application is a continuation-in-part of Application 07/967,685, filed October 27, 1992, now abandoned.

The invention relates to "an electroconvergent cautery system employing forceps or probes which produce sharply localized heating for cutting, vaporizing tissue and coagulating blood vessels when brought into contact with the same" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A surgical tool for surgically treating tissue in a patient, comprising:

a radio frequency power generator for creating an alternating current of a pre-selected frequency;

said radio frequency generator including an oscillator, a buffer amplifier and a power amplifier;

said buffer amplifier and said power amplifier being series connected;

an impedance matching means connected to said power amplifier for matching the impedance of a probe with the radio frequency generator;

a watts/ampere meter connected to said impedance matching means;

a loading and tuning coil connected to said watts/ampere meter;

a probe for contact with the tissue;

said loading and tuning coil being connected to said probe,

Appeal No. 96-0879
Application 08/101,228

said probe having a tip means for transmitting, receiving and focusing the radio frequency current at the region of the tissue such that the tissue being contacted is instantaneously vaporized, cut and/or cauterized.

The items relied upon by the examiner as evidence of obviousness are:²

Yamanashi et al. (Yamanashi)	5,019,076	May
28, 1991		

The statement relating to Yamanashi appearing on page 10 in the appellants' specification.

Claims 1 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamanashi in view of the statement appearing on page 10 in the appellants' specification.

² In both the final rejection (Paper No. 5) and answer (Paper No. 10), the examiner relies on U.S. Patent No. 3,963,030 to Newton and U.S. Patent No. 4,092,986 to Schneiderman to support his position on appeal. Neither of these patents, however, is included in the statement of the appealed rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered the teachings of Newton and Schneiderman in reviewing the merits of the appealed rejection.

Yamanashi discloses

a surgical tool comprising:

(a) a radio frequency source means for creating an electromagnetic field in the vicinity of tissue to be surgically treated; and

(b) an electromagnetic field focusing probe means for focusing the radio frequency energy produced by the radio frequency source means at the region of the tissue making contact with the tip of the electromagnetic field focusing probe such that the tissue being contacted is instantaneously vaporized, producing simultaneously a cutting and cauterizing effect [column 1, line 67 through column 2, line 10].

The radio frequency source means includes a signal generator 10 for producing an oscillating electrical signal of pre-selected frequency, an amplifier 12 for amplifying the signal, a meter 16 for monitoring the amplified signal, an impedance matcher 18 for adjusting the impedance between the signal generator/amplifier and an inductive applicator, and an inductive applicator in the form of a solenoid coil 14 for inducing an electromagnetic field in the vicinity of the tissue to be surgically treated. These components are connected to one another as shown in Figure 1.

The electromagnetic field focusing probe means consists

Appeal No. 96-0879
Application 08/101,228

of a conductive metal probe 22 having an exposed tip 20, a current monitor 24 for measuring the electrical current induced in the probe and a tuner 26 for adjusting and optimizing the induced electrical current passing through the probe. These components are connected to one another and to ground as shown in Figure 2.

The statement relating to Yamanashi appearing on page 10 in the appellants' specification reads as follows:

The cautery instruments of [appellants'] Figures 2, 3, 4 and 5 are to be utilized with electrical circuitry illustrated in [appellants'] Figure[s] 6 and 7. Inasmuch as many of the components of that shown in Figure 6 are identical or similar to that taught in U.S. Patent No. 5,019,076 [Yamanashi], reliance upon said patent is made to complete this disclosure, if necessary. In other words, the parameters or specifications of the various components of Figure 6 will not be described since it is believed that the same are disclosed in U.S. Patent No. 5,019,076 or would be obvious to one having ordinary skill in the art.

The essence of the examiner's position in maintaining the appealed rejection is that

the applicant's [sic, applicants'] disclosure, particularly page 10, lines 11-20, explicitly admits the similarity between the immediate application claim limitations and the Yamanashi et al. prior art device, and further acknowledges that the changes necessary to arrive at the system specifically depicted in figure 6 (and set forth in the claims) of the immediate application would be obvious to the skilled artisan [answer, page 5].

The problem with the examiner's position, however, is that the statement in the appellants' specification does nothing of the sort. The admissions in the statement pertain to the parameters or specifications of various individual components of the appellants' claimed surgical tool, and not to the claimed surgical tool as a whole. There is no reasonable basis in the statement to infer any admission by the appellants that the claimed surgical tool would have been obvious within the meaning of 35 U.S.C. § 103 in view of Yamanashi. Although Yamanashi discloses various of the components set forth in independent appealed claims 1 and 11, this reference does not disclose, and would not have suggested, the particular structural interrelationships which the claims require of these components. Thus, Yamanashi and the admissions relating thereto in the appellants' specification do not justify a

Appeal No. 96-0879
Application 08/101,228

conclusion that the differences between the subject matter recited in claims 1 and 11, and in claims 2 through 10, 12 and 13 which depend therefrom,³ and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Therefore, we

shall not sustain the standing 35 U.S.C. § 103 rejection of these claims.

The decision of the examiner is reversed.

REVERSED

³ In the event of further prosecution before the examiner, the dependencies of claims 12 and 13 should be corrected as indicated on page 3 in the brief (Paper No. 9).

Appeal No. 96-0879
Application 08/101,228

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LEE E. BARRETT)	
Administrative Patent Judge)	

Appeal No. 96-0879
Application 08/101,228

Zarley, McKee, Thomte, Voorhees
and Sease
801 Grand Avenue, Ste. 3200
Des Moines, IA 50309